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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,056	01/14/2002	Bruce H. Goodreau	M 6677 PCT/US	8438

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HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER
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OLTMANS, ANDREW L

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

# Office Action Summary

Application No.

09/914,056

Applicant(s)

GOODREAU ET AL.

Examiner

Andrew L Oltmans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claim 42 is objected to because of the following informalities:

In claim 42, line 5, the phrase "with can include halogen atoms", appears to be a typographical error. In view of the context of the claim it appears that the phrase should read "which can include halogen atoms". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### *Ara et al. 5,378,291*

3. Claims 22, 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ara et al. 5,378,291 (Ara).

Ara teaches a method of coating and a coating composition comprising (1) Cr<sup>6+</sup>, (2) 1-50% lubricant and (3) acryl-series polymer emulsion, including (poly)methacrylic acid, (poly)acrylate, acrylamide and methacrylamide (abstract; Table 1, col 12). The coating of Ara has improved lubricating properties (col 1, lines 13-15). The lubricant component of the coating composition is taught as including polyethylene wax and other waxes as well as esters and glycols, which are dispersed into the coating composition (col 6, lines 51-68). Ara teaches that

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the lubricants may be used in combination so as to further enhance the lubricating properties (col 7, lines 30-33). Ara further teaches the inclusion of non-ionic surfactant in an amount of 1 to 20% (col 7, lines 10-17). Ara teaches that the coating composition is formed by drying (i.e. without intermediate rinsing) the coating composition applied on materials (without intermediate rinsing) (col 9, lines 14-20 and 42-44). Ara teaches that the materials subjected to the inventive coating are iron, aluminum, zinc, tin, copper and their alloys (col 8, lines 44-49). Ara teaches the amount of chromium on the dried coating is preferably 5-300 mg/m<sup>2</sup> (col 8, lines 63-65). The claims do not distinguish over the teachings of Ara.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### ***Ara et al. 5,378,291***

5. Claims 23-35, 37-40 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ara et al. 5,378,291 (Ara).

Ara teaches and is applied as set forth above in paragraph 3.

Ara fails to meet all the limitations of the instant claims in that Ara does not explicitly teach the exact same range of composition and dried coating content, the melting point of the polyethylene was, mixing of the masses of composition, nor the coefficient of sliding friction.

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However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious, because the range of composition and dried coating chromium content taught by the reference overlaps the range of composition of the instant claims, see MPEP 2144.05.

With respect to the coefficient of friction, one of ordinary skill in the art at the time that the invention was made would have considered the invention to have been obvious because process taught by the references is the same as the process recited in the claims and therefore one of ordinary skill in the art would expect that the products resulting from the process taught by the reference would be the same as the product resulting from applicant's process, including the coefficient of friction of the process, see MPEP 2112.01.

With respect to the melting point of polyethylene was, one of ordinary skill in the art would find the selection of the type of polyethylene wax obvious because the teaching of Ara is enabled, in that, the teachings contained therein are sufficient to teach one of ordinary skill in the art to carry out Ara's described process, including Ara's use of polyethylene wax. One of ordinary skill in the art would consider the selection of the appropriate polyethylene was well within the skill of one of ordinary skill in the art. Therefore, the melting point of polyethylene is obvious.

With respect to the mixing of masses in water, the instant claims are obvious because Ara's teaching of the aqueous dispersion implies that in order to have the aqueous dispersion masses of the individual component had to be mixed with water and would inherently either dissolve or disperse when they are brought together.

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*Response to Submission of the Affidavits of Noel Smith and Jim Reed*

6. The examiner notes the submission of the affidavits of Noel Smith and Jim Reed filed with the preliminary amendment filed August 21, 2001. The documents have been reviewed and the examiner requests that the applicant fully disclose the material information arising from the "legal action" referred to in the preliminary amendment filed August 21, 2001, see MPEP 2001.06(c).

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached 7:00-3:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Andrew L. Oltmans  
Examiner  
Art Unit 1742

July 25, 2003